

**California Bar Intellectual Property (IP) Section
Patent Standing Committee**

Minutes of Meeting of November 7, 2003

Location: Fairmont Hotel in San Francisco from 4:15-5:30 PM during the Annual Meeting for the California Bar IP Section (28th Annual IP Institute).

I. General Introductions

(1) Each attendee introduced himself/herself, and provided an email address to update the current Patent Standing Committee mailing list.

(2) Hank Sartorio, Ben Borson & Bob Payne introduced the Patent Standing Committee and detailed the opportunity it offers to members including:

(A) Speaking opportunities - both to IP attorneys of the Patent Standing Committee and non-IP attorneys of the Cal. Bar generally. Ben Borson suggested that the Bar sections should meet together and “cross-fertilize” with members of other sections and subsections; [and]

(B) Publishing opportunities – prepare articles for New Matter; and

(C) A chance to develop professionally and demonstrate commitment to enable moving up in the Cal. Bar.

(3) Hank Sartorio noted the Patent Standing Committee has held quarterly phone-in meetings in the past. Hank further noted an opportunity for a member to organize an in-person meeting with a phone tie-in at the Patent Standing Committee member’s office, similar to meetings held by the Copyright Standing Committee. The in-person meeting offers the advantage of law firm sponsorship so that attendees can receive CLE credit.

II. Secretary Election

Thomas Ward was elected Secretary of the Patent Standing Committee for 2004. Tom replaces Dabney Eastham who had been elected Co-Chair of the Patent Standing Committee for 2004 during the September 2003 teleconference.

III. Introduction of Carol Langford

Carol Langford provides an opportunity to the IP Section to increase its current involvement with Ethics presentations. Hank Sartorio introduced Carol Langford who is currently the chair of the ABA IP Ethics Advisory Committee, as well as having her own practice in the Bay Area. She is a consultant and expert witness on Ethics in Patent

Matters, and an adjunct professor on legal ethics at the University of San Francisco School of Law.

Carol offered the opportunity for the ABA IP Ethics Committee and the Patent Standing Committee to work together in the future to potentially provide an ethics and IP presentation or publication.

Carol detailed her current work with the ABA. She was preparing a 75-page report on Ethics and IP lawyers. The report included three main sections with content described as follows:

- I: Conflicts - Carol noted hypotheticals involving issues such as conflicts of interest, fees, investment in clients, applicable law, and confidentiality. Carol noted that the ABA would have an IP Ethics Opinion on Conflicts published in the near future.
- II. Discipline - Carol noted she had collected disciplinary reports from selected states. In California, 1% of the disciplined attorneys are IP attorneys whereas 2% of the discipline cases brought were IP related. She noted most states deferred to the PTO to provide discipline. The disciplinary cases often involve failure to represent, competence, and substance abuse issues.
- III. Legal Malpractice - She noted as an example of an IP legal malpractice action the failure to meet foreign filing dates as in a recent case in which the verdict went against Fish & Richardson, and that damage uncertainty made malpractice insurance difficult to obtain.

Carol invited comments from IP lawyers regarding ethics as to what could be done better. She would like us to send her any practice tips we may have concerning how to avoid ethical problems in the IP field.

Patent Standing Committee Members inquired about the copyright license required by the ABA for Carol's publication, and noted only a minimal copyright release or license required by the Cal. Bar. Members mentioned a possible interest of the Cal. Bar IP Section in publishing the resulting paper, and providing assistance to Carol. Ben Borson offered to review her completed manuscript. An interesting topic for a separate paper to be written for the California Bar was noted to be the intersection of the PTO and California rules of practice or professional responsibility.

Carol can be contacted at langford@usfca.edu

IV. Planning For Future Patent Standing Committee Meetings

(1) Four quarterly teleconferences were planned for January, April, July and October of 2004. In person meetings could optionally be planned with CLE being available if a member's law firm was interested.

(2) Meeting Notice would be given a couple of weeks in advance of the meeting by email with a request sent for topics for presentation at that time.

(3) Meeting times were proposed at Wednesday approximately 2:00PM lasting around 1.5 hours.

Thomas A. Ward
Secretary, Patent Standing Committee
email: taw@fdml.com
phone: 415.362.3800